

REMARKS

Claim Status

New claim 24 has been added herein. Accordingly, claims 1-24 are pending.

Claim 8 has been amended in view of the restriction requirement, and further to clarify a typographical error in the claim in the previously submitted Amendment "A".

Claims 3, 7 and 18 have been withdrawn in view of a restriction requirement.

Accordingly, claims 1, 2, 4-6, 8-17 and 19-24 are at issue.

Priority

The reference in paragraph 2 (page 2) of the DETAILED ACTION to this application being "a 371" of PCT/JP/02/12409 and related Japanese documents is not understood. This application is based on PCT/ES04/00511 (November 17, 2004 371(c) date), claiming priority in Spain P200302806 (filed November 28, 2003). The correct information is listed in PAIR. To the extent that this incorrect reference is material to this Office Action, it is requested that such reference be withdrawn.

Claim Objections

Claim 1 has been amended to remove (A1) and the therefore unnecessary phrase defining "W" in view of the restriction requirement and the elected invention.

Claim 8 has also been amended to removed the chemical formulas (IA1b) and (IA1c) in view of the restriction requirement and the elected invention.

Additionally, it should be noted that several formulas were inadvertently omitted from claim 8 in Amendment "A" dated June 16, 2009. Specifically, formulas (IA1a), (IA2a) and

(IA3a), which were in claim 8 originally (see the Preliminary Amendment dated May 17, 2006), were unintentionally omitted from claim 8 when reproduced in Amendment "A"¹. Therefore, formulas (IA1a), (IA2a) and (IA3a) have been included in claim 8 again. Further, inasmuch as (IA1a) relates to non-elected Group I, while it reappears in claim 8, it is also in brackets in order to indicate clearly that it is to be deleted from the claim in view of the restriction requirement.

Claim 17 has been amended, in view of the restriction requirement to delete the two subparagraphs belonging to groups I and III-IV.

Claim Rejections

All of pending claims 1, 2, 4-6, 8-17 and 19-23 have either been rejected as being indefinite under 35 U.S.C. 112. These rejections have been variously addressed by the amendments herein as detailed below.

i.

The claims have been variously amended to remove the uses of "general".

ii.

While it is respectfully submitted that those skilled in the art would understand the meaning of "hydroxyl protective group", claim 1 has been amended to specify that

¹Amendment "A" did not indicate that claim 8 was amended, and rather identified it as "Previously Presented".

"hydroxyl protective group" is "selected from ethers, esters, cyclic acetals and ketals, and cyclic ortho esters".

Given that amendment to claim 1, the specification has also been amended to include language from the incorporated materials detailing that group. Specifically, the specific list of protection for hydroxyl group given in the referenced Green book has been copied into the specification. Though it is respectfully submitted that this list is not required by PTO rules, in view of the Office Action it is also recognized that inclusion of that list (which indicates not only that ethers, esters, cyclic acetals and ketals, and cyclic ortho esters are such protection, but additionally identifies specific compounds) may be more convenient to readers of the patent when issued.

These amendments to the specification and claim 1 are submitted to be appropriate under 37 C.F.R. 1.57 for the following reasons:

1. 37 C.F.R. 1.57(b)(1) states that an incorporation by reference must be set forth in the specification and must "[e]xpress a clear intent to incorporate by reference by using the root words 'incorporat(e)' and 'reference' (e.g., 'incorporate by reference')".
2. While the present application does not use the root words "incorporat(e)" and "reference" required in 1.57(b)(1), Applicant respectfully submits that incorporation may nonetheless be accomplished in view of 37 C.F.R. 1.57(g)(1), which states that:

A correction to comply with [37 C.F.R. 1.57(b)(1)] is permitted only if the application as filed clearly conveys an intent to incorporate the material by reference. A mere reference to material does not convey an intent to incorporate the material by reference.

3. Such an intent is clearly conveyed at page 4 of the specification, which in the description indicates very specifically that

"R is any of the hydroxyl protective groups of those described in Green TW *et al.* 'Protective groups in Organic Synthesis', Third Edition (1999), Ed. John Wiley & Sons (ISBN 0-471-16019-9)".²

Quite clearly, this is not a "mere reference" to that book, but rather is intended to specify that the "hydroxyl protective groups" are defined by the groups identified in that book.

4. Moreover, it should not be overlooked that this is an English language translation National Stage application based upon a Spanish language PCT application claiming priority in a Spanish language application in Spain. Common sense would indicate that it could not be expected that the "magic" English language "incorporated by reference" phrase would have been used. In this respect, the undersigned has also been advised by our Spanish associate (who filed the Spanish priority application) that the Spanish Patent Office has no rules requiring that any "magic words" such as the "incorporated by reference" be used. Moreover, they advise that the Spanish Patent Office frequently assumes the criteria used by the European Patent Office as being its own criteria, and the EPO "Guidelines for Examination in the European Patent Office" states that the expression "herein incorporated by reference" should not only not be used, they should be deleted (Guidelines C-II.4.19, 4th paragraph). For this reason, it is usual practice in Spain to not include that expression in European Patent applications and, accordingly, it is

²This specific identification of the book meets the requirement of 37 C.F.R. 1.57(b)(2) that the reference "clearly identify" the publication.

also not included in Spanish patent applications in order that they may be extended later to Europe without modifying the text. Further, since the EPO requires that "the features [that have to be incorporated] are precisely defined and identifiable within the total technical information in the reference document", in practice this means that Spanish (and EPO) applications simply sufficiently identify a referenced document and specify the portions of that document which are relevant. In this case, therefore, Spanish/EPO requirements were met by clearly identifying that the incorporated materials are the list of the hydroxyl protective groups cited in the document.

5. Further to 37 C.F.R. 1.57(e), should the Examiner desire a copy of the document on which the amendment to the specification is based, a copy of pages 10-14 of Green TW *et al.* 'Protective groups in Organic Synthesis', Third Edition (1999), Ed. John Wiley & Sons (ISBN 0-471-16019-9) is submitted herewith. These pages include the index to the chapter entitled "Protection for the Hydroxyl Group Including 1,2- and 1,3-Diols", with the compounds of the hydroxyl protective group clearly and precisely listed. The amendment to the specification lists those same compounds, whereas the amendment to claim 1 indicates that the "hydroxyl protective group" phrase is selected from the various groups of compounds also included in the Green index.
6. Also further to 37 C.F.R. 1.57(e), the undersigned hereby states that the copy submitted herewith consists of the same material incorporated by reference in the application.

7. Finally, further to 37 C.F.R. 1.57(f), the undersigned hereby states that the material inserted by this amendment into the specification is the material previously incorporated by reference and that the amendment contains no new matter.

In summary, claim 1 is now submitted to be definite under 35 U.S.C. 112 in its recitation of the "hydroxyl protective group".

iii.

Claim 9 has been amended to remove the phrase beginning with "if so desired ..."

iv.

With respect to claim 19, it is respectfully noted that the claim does not require a process step of deriving photosensitizers from anthracene, acridine or phenazine. Rather, claim 19 recites a process in which the step of UV or VIS light irradiation (recited in base claim 17) occurs in the presence of (1) (a) iodine or diphenyl selenide and (b) diffuse light, or (2) particular photosensitizers (the particular photosensitizers being those derived from anthracene, acridine or phenazine). The derivation of such photosensitizers is well known in the art as evidenced by, for example, the attached Exhibit A (Choudhry *et al.*, J Org. Chem. 1993, 58,946), Exhibit B (Andrews *et al.* J. Org. Chem. 1986, 51,4823) and Exhibit C (y Gielen *et al.* Recueil, Journal of the Royal Netherlands Chemical Society, 99, 1980). In any event, the particular method(s) by which such photosensitizers might be derived from anthracene, acridine or phenazine does not form a part of the invention; rather the invention is concerned with a use of the particular photosensitizers independent of whatever process might be used to derive them from anthracene, acridine or phenazine.

v.

Claim 22 has been amended to clarify that it is the claim 1 compound and not some use of a compound which is being claimed.

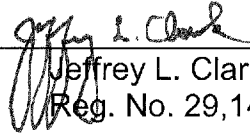
vi.

New claim 24 has been added to further specify that the hydroxyl protective group is selected from silyl-ethers and esters. Such groups are not only supported by the incorporated Green disclosure, but also at paragraphs [0019] and [0024] of Applicant's disclosure as published (page 5, lines 2-3, lines 10-12 of the application as filed).

In view of the above, claims 1-24 are now submitted to be in condition for allowance.
Early notification to that effect is respectfully requested.

Respectfully submitted,

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